

REMARKS

A. Restriction Request

Restriction to one of the following inventions was requested by the Examiner:

- I. Claims 1-32, and 36-37, allegedly drawn to an interactive media guide with parental control features, classified in class 725, subclasses 28 and 30.
- II. Claim 33-35, allegedly drawn to a method for a system operator to configure an interactive media guide at the server, classified in class 725, subclass 93.

The Applicants, which had provisionally elected the invention corresponding to claims 1-32 and 36-37, hereby re-affirm this election as requested by the Examiner. However, Applicants respectfully maintain that claims 1-32 and 36-37 are not limited to an interactive media guide with parental control features, as alleged in the Office Action.

B. Scope of Provisional Application

The Office Action states that the information disclosed in provisional patent application number 60/138,756 only comprises the information of pages numbered 1-5. The remainder of the provisional application was allegedly not properly incorporated into the provisional application such that the current application would receive the benefit of an earlier filing date.

Applicants respectfully maintain that the provisional patent application includes the contents of all the pages submitted by Applicants as part of the provisional patent application, including all 162 pages of specification that were submitted, as indicated by Applicants in the Provisional Application For Patent Cover Sheet dated June 11, 1999. Applicants also respectfully maintain that portions of the specification that are physically included as part of an application need not be incorporated by reference.

C. Request For Information By Examiner

1. The Examiner has requested information regarding the inventorship of the claimed material. The inventors of the currently claimed material remain as identified by the Patent Application Declaration filed with the current patent application (Dean Jerding, Robert Banker,

Arturo Rodriguez, Valerie Gutknecht, and Shashi Goel).

2. The Examiner has requested that Applicants provide clarification on the record as to whether any of the documents included in the provisional application constitute prior art with regard to the current application. These documents include:

- Client User Interface Specification for Video-On-Demand Application Development on the Explorer 2000™ Digital Home Communications Terminal, revision 1.10 of 8/31/98;
- VOD Title Catalog Format;
- VOD Client Software Design Specification, version 0.5 of 4/23/98;
- Video-On-Demand Architecture Specification for the SARA VOD Application Server Interface;
- The "AIS VOD Component" Overview;
- The "Generic VOD Architecture" Overview;
- System Architecture Specification for Video-On-Demand Application Development on the Explorer 2000™ Digital Home Communications Terminal, revision 1.01r of March 1999;
- System Architecture Specification for Service Group Determination of Scientific Atlanta Digital Broadband Delivery System, revision 1.00 of February 1999;
- System Architecture Specification Digital Broadband Delivery System User-to-Network Configuration, revision 1.00 of June 1999; and
- System Architecture Specification Digital Broadband Delivery System Service Interactive Sessions, revision 1.00 of June 1999;

Applicants believe that the provisional application, which comprises the above referenced

documents, does not constitute prior art with regard to the current application. Furthermore, Applicants maintain that the above-referenced documents are not printed publications that describe the claimed aspects of the invention prior to the filing of the instant application, as alleged by the Examiner.

3. The Examiner has requested information regarding the "Client User Interface Specification for Video-On-Demand Application Development on the Explorer 2000™ Digital Home Communications Terminal, revision 1.10 of 8/31/98" document drafted by Shashi Goel ("8/31/98 Document") that was part of U.S. Provisional Application having serial number 60/138,756 filed June 11, 1999. The Examiner alleges that the 8/31/98 Document discloses that the claimed invention was "to be deployed for demonstration in the field, in September 1998" (Page 3, Section 1.2).

The 8/31/98 Document discloses "This design is for the User Interface for the Phase 1 VOD Client application to be deployed for demonstration in the field, in September 1998." Applicants do not believe that there was such a demonstration prior to the effective filing date of the current application (June 11, 1999).

4. The Examiner has requested information regarding the "System Architecture Specification for Video-On-Demand Application Development on the Explorer 2000™ Digital Home Communications Terminal, revision 1.01 of March 1999" document drafted by Timothy Addington ("March 1999 Document"). The Examiner points out that the March 1999 Document discloses that the "S-A proprietary notice" has been removed from the document and that it was "released to Pegasus VOD Design team" (Page ii, Revision History).

If in fact the priority notice was effectively removed as indicated in the document, then it would signify that the March 1999 Document would no longer have been required to be kept confidential. Furthermore, if the March 1999 Document was disclosed to the Pegasus design team, then the disclosure would have been covered by a non-disclosure agreement whereby the Pegasus design team was contractually obligated to keep such information confidential. In addition, the release date indicated in the March 1999 document is less than one year prior to the effective filing date of the current application (June 11, 1999). Also note that the March 1999 Document, which discusses DSM-CC signaling architecture, does not disclose the claimed

invention. Therefore, the prior art status of the March 1999 document is not relevant since Applicants do not have any claims that specifically claim DSM-CC signaling.

If the above comments regarding the provisional application have not addressed the Examiner's concerns, then Applicants are willing to provide additional comments or information requested by the Examiner.

D. Objections to Drawings

Applicants have amended FIGS. 4C, 4D, 4H, 7, and 19A responsive to the Examiner's objections, as indicated above. FIG. 5 has not been amended to exclude numerals 193 and 195 since such numerals may be found on line 14 of page 14 of the current application. FIG. 4E was not amended since the specification has been amended to include the numerals 98 and 89. Furthermore, no figures were added to show features in claims 29-32 for at least the reason that claims 29-32 are cancelled.

E. Objections to the Disclosure

The Abstract and the paragraphs starting on lines 3 and 11 of page 5, on lines 4 and 13 of page 10, and on line 25 of page 19 have been amended as shown above responsive to the Examiner's suggestions.

F. Official Notices in Office Action

The Examiner has taken Official Notices that it is notoriously well known in the art to provide a list of various languages in which the guide may be displayed, and to present help screens.

According to MPEP 2144.03, "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." MPEP 2144.03 also states that "If such notice is taken, the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge."

Applicants respectfully traverse the Examiner's Official Notices for at least the following

reasons:

1. The facts sought to be established by the Official Notices are not capable of “instant and unquestionable demonstration as being well-known.”
2. The bases for the Official Notices were not set forth explicitly.
3. The Examiner did not provide specific factual findings predicated on sound technical and scientific reasoning to the support the conclusions of common knowledge.
4. The Examiner failed to cite documentary support for the Official Notices.

G. Claim Rejections and Objections

Claims 1-37 have been cancelled without prejudice, waiver, or disclaimer. Therefore, rejections of and objections to claims 1-37 are rendered moot. Applicants are not addressing the validity of all assertions made by the Examiner regarding claims 1-37 since the validity of such assertions may not be relevant to the allowance of the currently pending claims 38-65. Therefore, Applicants should not be presumed to agree with any statements made by the Examiner regarding claims 1-37 unless otherwise specifically indicated by Applicants. Nevertheless Applicants traverse any assertions by the Examiner that the specification is not enabling.

For example, claims 3-15, and 36-37 were rejected under 35 U.S.C. 112, first paragraph, because the specification allegedly did not reasonably provide enablement for "displaying a main screen of said interactive media guide denoting that active session is not present." The specification allegedly did not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Applicants traverse this rejection and maintain the specification provides enablement for "displaying a main screen of said interactive media guide denoting that active session is not present". For example, such enablement can be found in steps 193 and 195 of FIG. 5 and in the following portion of the specification: "The MOD application client 65 then checks its internal state to determine if the user currently has any current rentals 193. If not, the MOD title catalog screen 197 (FIG. 8A) is displayed, as in step 195." (Page 14, lines 29 and 30).

Claim 29 was rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement. Claim 29 allegedly included subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it

pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, the Examiner was unclear as to where support is found within the specification such that the "interactive media guide is configurable" to "change to a desired language format." Applicants respectfully traverse this rejection and maintain that such enablement is provided by the following portion of the specification: "As a non-limiting example, a French speaking user may configure, by an interface (not shown) presented by the MOD application client 65 to present the purchased MOD title in French language audio as opposed to, for example, and English language default setting. Additionally, the DHCT 16 may, upon the user initially configuring the language, set the default for future presentations to the newly selected language. Alternatively, the MOD application client may access the language settings of the navigator 51 (FIG. 3) and present all purchased MOD titles according to that language setting—provided the chosen language is one included in the MPEG audio track of the MOD title." (Page 22, lines 18-24).

H. New Claims

Claims 38-65, which have been newly added, are adequately supported by the specification, including at least FIGS. 5 and 6 and their related descriptions. These newly added claims are allowable because they claim subject matter that is not disclosed, taught or suggested by the cited references. Consideration and allowance of these newly added claims is respectfully requested.

Claim 38

Claim 38 is allowable for at least the reason that none of the cited references teach, suggest, or disclose "providing a list of selectable VOD titles responsive to determining that the active VOD session does not exist."

Claims 39-50

Claims 39-50 are allowable for at least the reason that they depend from claim 38, which has been shown to be allowable over the cited references.

Claim 51

Claim 51 is allowable for at least the reason that none of the cited references teach,

suggest, or disclose “responsive to receiving the second user input identifying the first access code, prompting the user to provide a third user input identifying a second access code.”

Claims 52-55

Claims 52-55 are allowable for at least the reason that they depend from claim 51, which has been shown to be allowable over the cited references.

Claim 56

Claim 56 is allowable for at least the reason that none of the cited references teach, suggest, or disclose “provide a list of selectable VOD titles responsive to determining that the active VOD session does not exist.”

Claims 57-60

Claims 57-60 are allowable for at least the reason that they depend from claim 56, which has been shown to be allowable over the cited references.

Claim 61

Claim 61 is allowable for at least the reason that none of the cited references teach, suggest, or disclose “provide the user with the VOD presentation responsive to the DHCT receiving the first and second user inputs.”

Claims 62-65

Claims 62-65 are allowable for at least the reason that they depend from claim 61, which has been shown to be allowable over the cited references.

CONCLUSION

Applicants respectfully maintain that the currently pending claims 38-65 are in condition for allowance. Should the Examiner have any comments or suggestions that would place the subject patent application in better condition for allowance, he is respectfully requested to telephone the undersigned attorney at (770) 933-9500.

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